

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons which follow. Claim 5 is amended into independent form. Claims 18-22 are cancelled. Claims 1-5 and 7-17 remain pending and are submitted for reconsideration.

Claims 1-3, 7-9 and 15 are rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,082,310 (Bauer). Claim 4 is rejected under 35 U.S.C. § 103(a) as unpatentable over Bauer in view of Canadian Patent Application 2,205,284 (Towler). Claim 16 is rejected under 35 U.S.C. § 103(a) as unpatentable over Bauer in view of DE 4424686 (DE '686).

The rejection should be withdrawn because the cited references (alone or in combination) do not disclose, teach or suggest the claimed invention. For example, none of the references disclose, teach or suggest a method that includes the step of "cutting a tear line ... while controlling the depth of cut relative to the support to precisely control the residual thickness of the tear line" as called for in claim 1.

The Office Action omits any discussion of the claim language quoted above. This omission is telling, because it is clear that Bauer does not disclose "controlling the depth of the cut relative to the support." Figs. 7 and 8 of Bauer disclose a system for controlling the depth of the cut. Fig. 7 of Bauer discloses a blade 72 for cutting an airbag cover. The depth of the cut is controlled by guide elements 74 that contact the surface of the cover skin 38. "The distance below the surface of the skin 38 that the cutting edge 76 protrudes corresponds to the depth of cut, and should be set accordingly." (Bauer at col. 5, lines 63-66). Thus, in Bauer, the depth of the cut is controlled relative the surface of the cover 38 and not relative to any support. Bauer also discloses that the depth of the cut can be varied by using a cam control 78 or other arrangement. (Bauer at col. 6, lines 9-16). However, there is no disclosure of controlling the depth of the cut relative to the support as called for in claim 1. The method of Bauer would produce unsatisfactory results because, for example, natural skins and leather usually have a varying thickness which consequently results in varying residual thickness of the tear line.

Bauer teaches that compression of the skin material should be avoided by placing the skin 38 on a bed of neoprene rubber 77. However, avoiding compression of the skin material does not account for any variation in the thickness of the skin material and, thus, does not allow the depth of the cut to be controlled relative to the support as called for in claim 1.

None of the cited art cures the deficiencies of Bauer discussed above. Thus, all of the elements of claim 1 are not disclosed, taught or suggested by the prior art and the rejection should be withdrawn. Reconsideration and withdrawal of the rejection is respectfully requested. Claims 2-4 and 7-17 depend from claim 1 and are allowable therewith, for at least the reasons set forth above, without regard to the further patentable limitations contained therein.

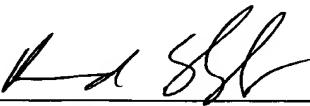
As mentioned above, claim 5 has been rewritten in independent form. Claim 5 is rejected 35 U.S.C. § 103(a) as unpatentable over Bauer. Claim 5 contains all of the elements of claim 1 and is, therefore, allowable with claim 1, for at least the reasons set forth above, without regard to the further patentable limitations contained therein.

Furthermore, the rejection of claim 5 should be withdrawn because the Examiner has failed to make a *prima facie* case of obviousness. The Examiner contends it would be obvious to modify Bauer to provide an oscillating cutter, because “applicant has not disclosed that the oscillating cutter solves any stated problem or is for any particular purpose and it appears that the **invention** would perform equally well with [an] oscillating cutter.” (Office Action at p. 4)(emphasis added). The Examiner has improperly placed the burden on the Applicants. The Examiner has the initial burden to establish a *prima facie* case of obviousness. Also, to establish a *prima facie* case of obviousness the Examiner must identify some suggestion or motivation to modify the disclosure of Bauer. MPEP § 2142. The Examiner has identified no motivation. The Examiner merely states that “the invention would perform equally well” with our without an oscillating cutter. Thus, the Examiner is clearly making the rejection while relying on the Applicants disclosure of their “invention” and resorting to impermissible hindsight reasoning. Reconsideration and withdrawal of the rejection is respectfully requested.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application is respectfully requested. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would expedite allowance of the application.

Respectfully submitted,

Date: June 11, 2003

By: 

FOLEY & LARDNER  
Customer Number: 22428



22428

PATENT TRADEMARK OFFICE

Telephone: (202) 672-5582  
Facsimile: (202) 672-5399

Howard N. Shipley  
Attorney for Applicant  
Registration No. 39,370

SHOULD ADDITIONAL FEES BE NECESSARY IN CONNECTION WITH THE FILING OF THIS PAPER, OR IF A PETITION FOR EXTENSION OF TIME IS REQUIRED FOR TIMELY ACCEPTANCE OF SAME, THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE DEPOSIT ACCOUNT NO. 19-0741 FOR ANY SUCH FEES; AND APPLICANT(S) HEREBY PETITION FOR ANY NEEDED EXTENSION OF TIME.